

REMARKS

Claims 1 through 17 are pending in this Application. Claims 1 and 7 have been amended. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the penultimate paragraph on page 17 of the written description of the specification, noting that the amendment to claim 7 comes at the Examiner's suggestion. Applicants submit that the present Amendment does not generate any new matter issue.

Claim Objection.

The Examiner objected to claim 7 identifying a perceived informality and courteously suggesting remedial language. In response claim 7 has been amended consistent with the Examiner's suggestion, thereby overcoming the stated basis for the objection. Accordingly, withdrawal of the objection to claim 7 is solicited.

Claims 1 through 11 and 14 were rejected on the ground of double patenting of the obviousness-type over claims 1 through 4, 5, and 8 of U.S. Patent No. 7,643,034 (the "'034 Patent").

Claims 1 through 7 and 9 through 14 were rejected on the ground of double patenting of the obviousness-type over claims 1, 3, 4, 9 through 15, 19, and 20 of U.S. Patent No. 7,569,323 (the "'323 Patent").

Each of the above-mentioned rejections on the ground of double patenting of the obviousness is traverse as being without any basis. Neither the '034 Patent nor the '323 Patent shares a common inventorship or common assignee with the present Application. Further the

present Application was filed on January 14, 2005, which precedes the July 26, 2006 filing date of the '323 Patent and precedes the January 30, 2007 filing date of the '034 Patent. Accordingly, neither the '034 Patent nor the '323 Patent constitutes prior art with respect to the claimed invention. Applicants therefore submit that neither of the above-mentioned rejections on the ground of double patenting of the obviousness is legally viable and, hence, solicit withdrawal thereof.

Claims 1 through 4 and 9 were rejected under 35 U.S.C. §102(e) for lack of novelty as evidenced by Komoriya et al. ("Komoriya").

In the statement of the rejection, the Examiner asserted that Komoriya discloses a polymer identically corresponding to the claimed invention. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. §102(e) requires the identical disclosure in a single reference of each element of a claimed invention, as those elements are set forth in the claims, such that the claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Therasense, Inc. v. Becton, Dickinson and Company*, 593 F.3d 1289 (Fed. Cir. 2010); *Praxair, Inc. v. ATMI, Inc.*, 543 F.3d 1308, (Fed. Cir. 2008); *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367 (Fed. Cir. 2002); *Candt Tech Ltd. v. Resco Metal & Plastics Corp.*, 264 F.3d 1344 (Fed. Cir. 2001). Further, as a matter of procedural due process of law, the Examiner is required to specifically identify where in an applied reference is alleged to disclose each and every feature of a claimed invention, particularly when such is not apparent as in the present case. *In re Rijckaert*, 9 F.3d 1531 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452 (Fed. Cir.

1984). Moreover, there are fundamental differences between the claimed immersion upper layer film and Komoriya's polymer that scotch the factual determination that Komoriya discloses, or even remotely suggests, an immersion upper layer film composition identically corresponding to those claimed.

The Examiner relied upon page 9 [0124] of Komoriya, asserting that propylene glycol is disclosed as a solvent for Komoriya's polymer. However, as one having ordinary skill in the art would have understood, propylene glycol is NOT a monovalent alcohol, as required by independent claim 1. On this basis alone, the imposed rejection cannot stand. But there are other differences between the claimed invention and Komoriya that undermine the factual determination of lack of novelty.

Specifically, independent claim 1 requires that the solvent of the claimed invention has a specific property, i.e., it must not cause intermixing between the upper layer film and an underlying photoresist film after being coated thereon. Contrary to the Examiner's assertion, this is an affirmative limitation on the solvent of the claimed immersion upper layer film composition, requiring that it be capable of performing in a certain manner-**it is a property of the solvent, not a product by process limitation and, hence, cannot be ignored.** *In re Garnero*, 412 F.2d 276 (C.C.P.A. 1977). In other words, the solvent must be capable of performing as specified in independent claim 1, i.e., it must have that property. On the other hand, Komoriya neither discloses nor suggests the notion of selecting a solvent that avoids such intermixing, as in the claimed invention. Silence in a reference is no substitute for the requisite facts. *In re Burt*, 356 F.2d 115 (C.C.P.A. 1966).

The Examiner also asserted that Komoriya's polymer is used as an antireflective layer on a resist, referring to page 10 [0125] of Komoriya. Applicants disagree. There is no apparent

disclosure in Komoriya, including the relied upon {0125} as well as [0126] of applying Komoriya's polymer to a resist. Komoriya merely discloses the use of the polymer as an antireflective layer on a substrate, such as a display panel [0125] or as a component of a resist composition [0126], thereby teaching away from the claimed invention.

The above argued functionally significant structural differences between the claimed upper layer film composition and Komoriya's polymer undermine the factual determination that Komoriya discloses an upper layer film composition identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 1 through 4 and 9 under 35 U.S.C. §102(e) for lack of novelty as evidenced by Komoriya is not factually viable and, hence, solicit withdrawal thereof.

Claims 1 through 4 and 9 were rejected under 35 U.S.C. §102(e) for lack of novelty as evidenced by Li et al. ("Li").

This rejection is traversed. Specifically, Applicants are entitled to an effective filing date of January 15, 2004, based on priority application number 2004-008466, which antedates the May 27, 2004 filing date of Li. Accordingly, Li is not prior art with respect to the claimed invention. A certified English language translation of priority application number 2004-008466 is being prepared and will be submitted when received.

Based on the foregoing, Applicants solicit withdrawal of the rejection of claims 1 through 4 and 9 under 35 U.S.C. §102(e) for lack of novelty as evidenced by Li.

Claims 1, 3, 5, 6, and 9 through 12 were rejected under 35 U.S.C. §103(a) for obviousness predicated upon Komoriya.

This rejection is traversed. Specifically, Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 1 through 4 and 9 under 35 U.S.C. §102(e) for lack of novelty as evidenced by Komoriya. The Examiner's additional comments regarding claims 5, 6, and 10 through 12 do not cure the previously argued deficiencies of Komoriya. Applicants, therefore, submit that the imposed rejection of claims 1, 3, 5, 6, and 9 through 12 under 35 U.S.C. §103(a) for obviousness predicated upon Komoriya is not factually or legally viable and, hence, solicit withdrawal thereof.

Claims 1, 3, 5, and 6 through 14 were rejected under 35 U.S.C. §103(a) for obviousness predicated upon Li.

This rejection is traversed. Specifically, Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 1 through 4 and 9 under 35 U.S.C. §102(e) for lack of novelty as evidenced by Li. The Examiner's additional comments regarding claims 5, 6 through 8, and 10 through 14 do not cure the previously argued deficiencies of Li. Applicants, therefore, submit that the imposed rejection of claims 1, 3, 5, and 6 through 14 under 35 U.S.C. §103(a) for obviousness predicated upon Li is not factually or legally viable and, hence, solicit withdrawal thereof.

Based upon the foregoing, it is apparent that the imposed objection and rejections have been overcome, and that all pending claims are in condition for allowance. Favorable consideration is therefore solicited. If any unresolved issues remain, it is respectfully requested

that the Examiner telephone the undersigned attorney at 703-519-9954 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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Date

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